

REMARKS/ARGUMENTS

Claims 1-13 are currently pending. Applicants have amended claims 1, 4, and 9. Applicants submit that no new matter has been inserted into the application as a result of these amendments.

Claims 1 and 9 stand objected to for various informalities.

Claim 4 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite.

Claims 1-13 stand rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter.

Claims 1-3 and 6-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,820,094 to Ferguson in view of U.S. Patent No. 6,401,206 to Khan et al., and further in view of U.S. Patent No. 5,659,164 to Schmid et al.

Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ferguson in view of Khan, further in view of Schmid, and further in view of IBM "Technical Disclosure Bulletin," issued July 1992.

Objection to the Claims

Claims 1 and 9 stand objected to for various informalities.

Claim 1 formerly recited at line 11 "at least two electronic documents." Claim 1 has been amended to instead recited "the at least two electronic documents."

Claim 9 formerly recited at line 14 "a secured stack" and "the secured stack" at lines 15-17. Claim 9 has been amended to recited "a secured stack object" and "the secured stack object."

Accordingly, Applicants respectfully request that the objections to the claims be withdrawn.

Rejections under 35 U.S.C. §112

Claim 4 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claim 4 stands rejected as being indefinite for reciting "a user" which is unclear whether "a user" recited in claim 4 refers to the same "a user" recited in claim 1.

Claim 4 has been amended to recite "the user."

Accordingly, Applicants respectfully request that the rejection of claim 4 under 35 U.S.C. §112, second paragraph be withdrawn.

Rejections under 35 U.S.C. §101

Claims 1-13 stand rejected under 35 U.S.C. §101 as being directed toward non-statutory subject matter. Independent claims 1 and 9 were rejected as being directed toward non-statutory subject matter for merely reciting an intended or field of use for the invention. Dependent claims 2-8 and 10-13, which depend from claim 1, stand rejected as incorporating the deficiencies of claim 1.

Applicants have amended claim 1 to recite "generating a staple data object representing an association of selected pages of at least two selected documents" and have amended claim 9 to recite "generating a stack object representing an association of selected pages and selected documents." Applicants submit that the amended claim language recite positive limitations and do not merely specify an intend use or field of use for the invention.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §101 be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-3 and 6-13

Claims 1-3 and 6-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ferguson in view of Khan, and further in view of Schmid.

Applicants submit that even if Ferguson, Khan, and Schmid were combined as suggested in the Office Action, the combination of Ferguson, Khan and Schmid fail to teach all of the features recited in independent claims 1 and 9. For example, claim 1 recites, in part:

accepting a staple instruction from the user, wherein for each of the at least two selected documents, if a document is not stored in a permanent storage, the document is copied to a permanent storage to create a permanent copy of the document and the staple data object is updated to refer to the permanent copy of the document;

cryptographically securing the combination of the pages of the at least two electronic documents of the staple data object in response to receipt of the staple instruction, thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time.

The combination of Ferguson, Khan, and Schmid fail to disclose or suggest at least these features of claim 1.

The combination of Ferguson, Khan, and Schmid fails to disclose or suggest "accepting a staple instruction from the user, wherein for each of the at least two selected documents, if a document is not stored in a permanent storage, the document is copied to a permanent storage to create a permanent copy of the document and the staple data object is updated to refer to the permanent copy of the document" as recited in claim 1. Ferguson merely describes creating a "clipped document" that allows a user to combine several documents into a compound document. The clipped documents of Ferguson are merely a "virtual storage feature" though, and "do not contain a copy of each component document." Instead, each clipped document has a corresponding STG file that includes links to the STG file of each of the component documents that comprise the clipped document. Ferguson, col. 15, line 15-col. 16, line 5. Therefore, it would be possible for one or more of the component documents of a clipped document to be altered or deleted. In contrast, the present invention recited in claim 1 advantageously creates a permanent copy of each stapled document or pages from a document that is not stored in permanent storage to ensure that the continued existence of an unaltered copy of each stapled document or pages from a document. Therefore, the combination of Ferguson, Schmid, and Khan fails to disclose or suggest at least this feature of claim 1.

The combination of Ferguson, Khan, and Schmid also fails to disclose or suggest "cryptographically securing the combination of the pages of the at least two electronic documents of the staple data object in response to receipt of the staple instruction" as recited in claim 1. The Office Action relies upon col. 3, lines 48-53 of Khan to teach this feature of claim

1. Kahn clearly describes attaching a "digital identity" of a signer of a document to a *single* document in order to ensure that modifications to the document can be detected. Khan, Abstract. Kahn is silent as to attaching digital identity to protect the integrity of an association of *multiple documents*, such as a combination of pages of at least two documents as recited in claim 1. Khan does not disclose that a single digital signature can protect the integrity of the association of multiple documents. In fact, Khan does not disclose or suggest associating multiple documents together for any purpose. Therefore, the combination of Ferguson, Schmid, and Khan fails to disclose or suggest at least this feature of claim 1.

The combination of Ferguson, Khan, and Schmid further fails to disclose or suggest "creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time" as recited in claim 1. The Office Action relies upon Schmid to teach this feature of claim 1. Schmid merely describes the use of barcodes or other optically recognizable machine readable indicators ("MRIs") that comprise "machine readable information about *where a document should be routed* over computer network, how to set scanning parameters in the scanner, and *additional operations to perform*, greatly increasing the efficiency and simplicity of creating, routing, and processing scanned image documents without operator or user intervention"(emphasis added). Schmid, Abstract. The barcodes of Schmid are thus very different than the "unalterable indicators" recited in claim 1. The unalterable indicator recited in claim 1 advantageously provides an indication that the association of selected pages and selected documents has not been altered. The MRI information of Schmid does not provide an indication that a scanned document cannot be altered, nor could the MRI information could be used to test the integrity of the scanned documents to determine whether the scanned documents have been altered. Therefore, the combination of Ferguson, Schmid, and Khan fails to disclose or suggest at least this feature of claim 1.

Therefore, for at least the reasons provided, even if Ferguson, Khan, and Schmid could be combined as suggested in the Office Action, the combination fails to disclose or suggest all of the features of claim 1. Independent claim 9 should also be allowable for similar reasons as claim 1, and others. Furthermore, dependent claims 2, 3, 6-8 and 10-13, which depend from

claim 1, should also be in condition for allowance at least due to their dependence from independent claim 1.

Accordingly, Applicants respectfully request that the rejection of claims 1-3 and 6-13 under 35 U.S.C. §103(a) be withdrawn.

Claims 4 and 5

Claims 4 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ferguson in view of Khan, further in view of Schmid, and further in view of IBM "Technical Disclosure Bulletin."

Claims 4 and 5 depend from claim 1, and the rejection of claim 1 is premised on the assertion that the combination of Ferguson, Khan and Schmid discloses or suggests the features recited in claim 1 and IBM discloses or suggests the remaining features of claims 4 and 5. As discussed above, however, the combination of Ferguson, Khan and Schmid does not disclose or suggest all features recited in claim 1. As best understood, IBM provides no teaching or suggestion that would remedy this deficiency. Therefore, the rejection is based on a flawed premise and cannot be maintained. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 4 and 5.

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Amdt. dated April 14, 2008
Reply to Office Action of December 12, 2007

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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